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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,424	02/13/2004	Robert H. Wollenberg	T-6319 (538-67)	9079
7590 05/18/2005			EXAMINER	
Michael E. Carmen, Esq. DILWORTH & BARRESE, LLP 333 Earle Ovington Blvd. Uniondale, NY 11553			LARKIN, DANIEL SEAN	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

**Office Action Summary**

Application No.

10/779,424

Applicant(s)

WOLLENBERG, ROBERT H.

Examiner

Daniel S. Larkin

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

***NOTE: Claims 10-39 have been renumbered 9-38 since original claim 9 is missing.***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

#### **OIL:**

The species of using a specific type of base oil as embodied in claims 1, 2, 29, 35, and 38

#### **ADDITIVE:**

The species of using a specific lubricating oil additive as embodied in claims 1, 3, 29, 36, and 38.

The species of using a specific lubricating oil additive as embodied in claims 1, 3, 4, 29, 37, and 38.

The species of using a specific dispersant as embodied in claims 1, 4, 29, 37, and 38.

The species of using a specific dispersant as embodied in claims 1, 3, 5, and 29, and 38.

The species of using a specific lubricating oil additive as embodied in claims 1  
28, 29, and 38.

**BASE OIL-INSOLUBLE MATERIAL:**

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 1 and 6-10, 19-23, 26, 29-34, and 38.

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 1, 11, 19-23, 26, 29-34, and 38.

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 1, 6, 12, 29-34, and 38.

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 6, 12, 13, 19-23, 26, 29-34, and 38.

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 1, 11, 13, 19-23, 26, 29-34, and 38.

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 1, 11, 13, 14, 19-23, 26, 29-34, and 38.

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 1, 11, 15, 16, 18-23, 26 29-34, and 38.

The species of using a specific, polar base oil-insoluble material as embodied in  
claims 1, 11, 17, 19-23, 26, 29-34, and 38.

**HOMOGENIZING TECHNIQUE:**

The species of using mechanical stirring to homogenize the sample as embodied in claims 1, 23, 19-23, 24, 26, 29-34, and 38.

The species of using ultrasonic agitation to homogenize the sample as embodied in claims 1, 23, 19-23, 25, 26, 29-34, and 38.

**Applicants are required to elect from the following species:**

1 type of oil; 1 type of lubricating oil additive; 1 type of base oil-insoluble material; and 1 type of homogenizing technique.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 19-23, 26, 27, 29-34, and 38 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Conclusion***

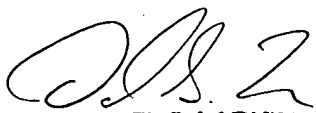
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Larkin whose telephone number is 571-272-2198. The examiner can normally be reached on 8:00 AM - 5:00 PM Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2856

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Larkin  
AU 2856  
03 May 2005



**DANIEL S. LARKIN**  
**PRIMARY EXAMINER**